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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

00-007

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on

April 18, 2006

Signature

Typed or printed name

Veronika S. Leliever

Application Number

09/609,253

Filed

June 30, 2000

First Named Inventor

Jay S. Walker

Art Unit

3626

Examiner

FRENEL, VANEL

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)



attorney or agent of record.

Registration number 50,252



attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

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April 18, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.



*Total of 5 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**CUSTOMER NO. 22927****Attorney Docket No.:** 00-007

Applicants: Walker et al.
Application No.: 09/609,253
Filed: June 30, 2000
Title: METHODS AND APPARATUS FOR INCREASING AND/OR
FOR MONITORING A PARTY'S COMPLIANCE WITH A
SCHEDULE FOR TAKING MEDICINES
Group Art Unit: 3626
Examiner: FRENEL, Vanel
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REQUEST FOR PRE-APPEAL REVIEW**after the Final Office Action mailed January 18, 2006**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

In response to the Office Action mailed January 18, 2006 (Paper No. / Mail Date 07112005), please consider the attached remarks and grant pre-appeal review of this application.

This document is filed by Applicants' representative on behalf of the present Applicants for patent. Accordingly, references in this document to "we," "us," "our," and the like will be understood as indicating the present Applicants.

R E M A R K S

- Claims 2, 3, 5-47, 50, 59 and 116-125 are pending in the present application
- Claims 2, 49, and 116 will be independent

A. Grounds for Rejection

All of Claims 2, 3, 5-47, 49-50 and 116-125 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,950,632 issued to Reber et al. ("Reber") in view of U.S. Patent No. 6,108,685 issued to Kutzik et al. ("Kutzik").

1. Independent Claims 2, 49 and 116

The Examiner has failed to establish a *prima facie* case of obviousness with respect to any of Claims 2, 49, and 116 (or any claims dependent therefrom).

(a) No suggestion of communication between two containers for storing medicine

Contrary to the Examiner's assertions, there is no suggestion in Kutzik or Reber of communication between two medicine containers, much less wireless communication. Also, neither Kutzik nor Reber suggests the desirability of having two medicine containers communicate with one another.

Unfortunately, the Examiner appears to have misread both the Kutzik and Reber references with respect to this subject matter. The Examiner asserts: "Reber discloses...wirelessly communicating a signal between the first container and a second container the second container adapted to store a second medicine (See Reber; Col.7, lines 43-67)." [Office Action, pages 2-3].

The cited portion describes medicine containers capable of communicating with a "medical communication apparatus 50." There is no suggestion in Reber that the "medical communication apparatus 50" is a medicine container or is adapted to store medicine. Accordingly, Reber does not suggest communication between containers for storing medicine.

The Examiner also asserts: "Kutsik [sic] discloses a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container (See Kutsik [sic], Col.15, lines 31-67)." [Office Action, pages 12-13].

We do not agree with the Examiner's interpretation of the cited portion, nor does Kutzik otherwise suggest communication between two containers for storing medicine. The cited portion describes a "user monitoring system" that can determine "whether they are having difficulty managing their medications." A "remote case monitoring system" may use data from the "user monitoring system." Nothing in the cited portion even hints at the ability or desirability of a container for storing medicine to communicate with another container for storing medicine.

Kutzik also describes a "medication self-management detection subsystem 116" that includes "medication containers 402" stored in a "medication holder 404," but, as in Reber, there is no suggestion that any such "medication containers 402" are able to communicate with one another, or that such communication would be desirable. [See FIGS. 4A, 4B, and 5 and

accompanying text at Columns 8-9]. In particular, FIG. 5 suggests only communication between a “medication holder 404” and a “system controller 110.” There is no suggestion that the “system controller 110” may store medicine.

Accordingly, no combination of the cited references teaches or suggests communication between containers for storing medicine. In particular, the cited references do not teach or suggest any of the features generally directed to:

- *wirelessly communicating a signal between a first container adapted to store a first medicine and a second container adapted to store a second medicine (Claim 2)*
- *a communication device adapted to wirelessly communicate at least one signal between the medicine container and at least one other medicine container (Claim 49)*
- *a first container for storing a first medicine, the first container being capable of wirelessly communicating with a second container for storing a second medicine (Claim 116)*

(b) No motivation to modify or combine the cited references to provide for all of the recited features

Contrary to the Examiner’s assertion, there is no evidence of a motivation to combine the Reber and Kutzik references. There is nothing in the cited references that even hints at the desirability of providing for two containers for medicine that can communicate with each other (much less communicate wirelessly).

2. Claim 2: No suggestion of an indication of a number of times that a second container is beyond a range in which a first container is able to communicate with the second container

Some embodiments of the present invention provide for proximity information to include the number of times each medicine container has been moved beyond a range wherein the medicine container may communicate with another medicine container. A level of compliance to a medicine schedule may be based at least in part on such proximity information [See, e.g., Specification, page 37, lines 1-7]. Independent Claim 2 recites features generally directed to *wirelessly communicating a signal including an indication of a number of times that the second container is beyond a range in which the first container is able to communicate with the second container and generating at least one code based at least in part on the signal, the at least one code indicating whether at least one party has complied with a schedule for taking the first medicine and the second medicine.*

Contrary to the Examiner’s assertion, Kutzik does not teach or suggest any such features. As discussed above, neither reference suggests the ability of containers for storing medicine to communicate with one another. Nothing in the cited portion of Kutzik (Col. 1, lines 43-52) (or anywhere else in Kutzik) even hints at ranges for communication or indicating a number of times something is beyond a range for communicating, much less with respect to containers for storing medicine. Thus, the cited references do not teach or suggest any such features or the desirability of compliance with a schedule for taking medicines that is based on an indication of a number of times one container is beyond a range in which another is able to communicate with it. Thus, the Examiner has failed to establish a *prima facie* case of obviousness of for independent Claim 2.

3. Claim 3

With respect to claim 3, the Examiner asserts that Reber teaches transmitting information regarding a first medicine from a first container to a second container and receiving information regarding the second medicine from the second container. Reber (including the cited portion) does not appear to teach any such features.

4. Claims 6-9

With respect to claims 6-9, the Examiner asserts that Reber teaches (i) detecting if the first container for storing medicine and the second container for storing medicine cannot communicate, (ii) determining if the first container and the second container are separated by a distance that prevents the first container and the second container from communicating, and (iii) determining a time when the containers are initially separated by a distance that prevents communicating. As discussed above, Reber (including the cited portion Col. 3, lines 2-25) does not even hint at the ability of medicine containers to communicate with each other at all, much less the desirability of determining if such containers cannot communicate (or such a time).

5. Claims 10-13

With respect to claims 10-13, the Examiner asserts that Reber discloses determining a distance between the first container and the second container based on a signal received wirelessly. Reber (including the cited portion) does not appear to teach any such feature.

6. Claims 14-17

With respect to claims 14-17, the Examiner asserts that Reber discloses tracking a location or identifying a location of at least one of the first and second containers. One cited portion (Col. 5, lines 9-30) discusses graphical representations of dosages. The other cited portion discusses how the “medical monitoring apparatus” can establish communication with medical personnel and can have “network access.” Accordingly, contrary to the Examiner’s assertion, neither the cited portions nor the rest of Reber appears to have anything to do with tracking a location of a medicine container.

7. Claims 23 and 43-45

With respect to claims 23 and 43-45, the Examiner asserts that Kutzik at Col. 8, lines 30-42 teaches detecting if the first container has been opened or closed. We do not agree. The cited portion describes only detecting (by means of a “switch 416”) if a “medication container” is present in a “medicine holder” or not. See also FIGS. 4B and 5. Nothing about the opening or closing of a medicine container is mentioned.

8. Claim 24

With respect to claim 24, the Examiner asserts that Reber teaches detecting a weight of the first container. We do not agree. The cited portion (Col. 9, lines 14-30) does not teach or suggest detecting weight to determine if a portion of medicine has been removed from a container. There is no evidence (much less substantial evidence) of such a feature in the record.

9. Claims 32-36

With respect to claim 32, the Examiner asserts that Reber teaches determining if the first medicine is incompatible with second medicine at Col. 7, line 60 to Col. 8, line 41. We do not agree. The cited portion describes only taking two different medicines at different times; it does not suggest that the medicines are incompatible or making such a determination. To the contrary, the description indicates that the user will be signaled to take both medicines, suggesting that the medicines are not incompatible. There is no evidence (much less substantial evidence) of the recited feature in the record. Further with respect to Claims **33-36**, the Examiner asserts that Reber discloses generating a warning if a first medicine is incompatible with a second medicine. We do not agree. The cited portion (Col. 8, line 29 to Col. 9, line 30) does not even remotely hint at what is asserted. There is no evidence (much less substantial evidence) of such a feature in the record. With respect to Claims **34-36**, contrary to the Examiner's assertion, Reber is devoid of any hint of a warning that two medicines are incompatible, much less storing or transmitting any such warning.

10. Claim 40

With respect to claim 40, the Examiner asserts that Reber teaches a micro-needle based device at Col. 7, lines 33-67. The cited portion does not even remotely teach or suggest a micro-needle based device. There is no evidence (much less substantial evidence) of such a feature in the record.

11. Claims 41-42

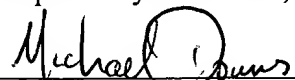
With respect to claims 41-42, Reber has nothing to do with determining whether two medicine containers can communicate. Contrary to the Examiner's assertion, nothing in the cited portion or otherwise in Reber remotely hints at determining if a container for storing medicine is positioned so as to communicate with another container for storing medicine, much less preventing a party from accessing at least one of the containers if they are so positioned. There is no evidence (much less substantial evidence) of such features in the record.

12. Claims 118-124

With respect to claim 118-124, the Examiner asserts that Reber discloses positioning containers for storing medicine so that they may communicate. We disagree, as discussed herein, because Reber is devoid of any hint of containers for storing medicine communicating with one another.

April 18, 2006
Date

Respectfully submitted,



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